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09/716,415	11/21/2000	Masaru Takeda	107904	8263
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OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			NGUYEN, HAI V	
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			2142	

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/716,415	<b>Applicant(s)</b> TAKEDA ET AL.	
	<b>Examiner</b> Hai V. Nguyen	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to the communication received on 17 October 2005.
2. Claims 1-22 are presented for examination.

#### ***Response to Arguments***

3. Applicant's arguments and amendments received on 17 October 2005 have been fully considered but they are not persuasive. Applicant's arguments are deemed moot in view of the new ground(s) of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., a search section for searching the output printing apparatus group managed by the managing section for one candidate output printing apparatus or a plurality of candidate output printing in response to a search request having search conditions from a terminal apparatus) to the independent claims 1, 5, 17, and 19-21, which significantly affected the scope thereof.

#### ***Drawings***

4. The drawings are objected to because miss-spelling word(s) on Figure 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes

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made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith** U.S. patent # **6,785,015 B1** in view of **Thorne** U.S. patent # **5,832,191**.

7. As to claim 1, Smith, System and Method For Monitoring A Computer System Processor or Peripheral, discloses an information output system comprising:

a managing section managing for managing a mail address for each output printing apparatus of an output printing apparatus group (*Smith, Abstract, method for monitoring a process or peripheral that may employ any command syntax and semantics for facilitate the transfer of information between the processes. For example, in a system according to various aspects of the present invention, commands and replies in any suitable syntax may be provided in the body of email messages to*

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*accomplish the purposes described in the table 1. In the system 100, for example, each peripheral (e.g., printer 108 or 112) is identified with its own unique email address, col. 5, lines 58-67; col. 15, line 5 – col. 16, line 27).* However, Smith does not explicitly disclose searching the output apparatus group managed by the managing section for one candidate output printing apparatus or a plurality of candidate output candidate output printing apparatuses in response to a search request having search conditions from a terminal apparatus.

In the same field of endeavor, Thorne, related Method And Apparatus For Automatically Enabling Communication With A Network Printer, discloses that searching an output printing apparatus group managed by the managing section for one candidate output printing apparatus (*one available printer*) or a plurality of candidate output printing apparatuses in response to a search request having search conditions from a terminal apparatus (*Thorne, wherein step d) causes a search to be made of communication data structures (CDS) 58 to determine which printers are available and match a client processor's print request requirements, (claim 3, col. 5, lines 29-31); the new instance CDS 58 includes, among other data, the name of the associated agent data structure, the address of new printer 12, data to enable communication with PSM 42, and further data which enables access to other procedures within program memory section 38, e.g., network interface/communication procedure 46, MOD update procedure 48 and status update procedure 50, (Thorne, col. 4, lines 8-23).*

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Thorne's teachings of

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searching which printers are available with the teachings of Smith, for the *purpose of greater system flexibility and reliability (Smith, col. 17, lines 43-56).*

Smith-Thorne discloses notifying said terminal apparatus (*user*) of the mail address of said candidate output printing apparatus or the plurality of candidate output printing apparatus found in a search by the search section (*Smith, col. 17, lines 12-56*), wherein the terminal apparatus issues an electronic mail to a destination mail address of a designate output printing apparatus (*Smith, print requests, col. 2, line 8 – col. 3, line 16; col. 9, line 30 - col. 11, line 60*), and wherein the destination mail address is based upon the mail address of said candidate output printing apparatus or the plurality of candidate output printing apparatus provided by the notifying section (*Smith, col. 2, line 8 – col. 3, line 16; col. 9, line 30 - col. 11, line 60; each peripheral (e.g., printer 108 or 112 is identified with its own unique email address, col. 5, lines 57-67); and*

Smith discloses distinguishing the designated output printing apparatus from said output printing apparatus from said output printing apparatus group based on the destination mail address of the electronic mail issued from said terminal apparatus, wherein said designated output printing apparatus produces printed output of outputting information included in the electronic mail issued from said terminal apparatus (*each peripheral (e.g., printer 108 or 112 is identified with its own unique email address, col. 5, lines 57-67; Message I/O 22 distinguishes data intended for printing from other network communication containing commands as described above (e.g., email) and stores the later in message data store 228 (e.g., formatted as a message containing a reply as*

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*discussed above) and accomplishes sending the data via network controller 214 onto Intranet 106, (col. 9, line 30 - col. 11, line 60)).*

It would have been obvious to one of ordinary skill in the computer networking art at the time of the invention was made that the claimed invention differed from the teachings of Smith only by the degree, e.g., in the claimed search request having search conditions. But this is no more a difference in a degree because the search request having search conditions or subscription request having publication criteria including a condition based on location or a condition based on information reported by another peripheral (Smith, col. 17, lines 43-56), they provide a selection for the user. The heart of the invention is providing a list or a table of the printers' email addresses for the user to search and to select an available printer based on its email address. Smith invention exactly was directed to the same purpose, i.e., to provide for a user an available printers based on their email addresses with greater system flexibility and reliability.

8. As to As to claim 2, Smith-Thorne discloses managing performance information for each of said output printing apparatuses, and said search section searches for said one candidate output printing apparatus or the plurality of candidate output printing apparatuses based on said performance information (*Thorne, various status indications concerning printer, col. 4, lines 23-33; (Smith, col. 9, line 30 - col. 11, line 60))*).

9. As to claim 3, Smith-Thorne discloses, wherein said managing section further manages installation position information for each of said output printing apparatuses, and said search section searches for said one candidate output printing apparatus or the plurality of candidate output printing apparatuses based on said installation position

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information (*Thorne, Fig. 1, address of printer in CDS 58; (Smith, col. 9, line 30 - col. 11, line 60)*).

10. As to claim 4, Smith-Thorne discloses an accounting processor for performing accounting processing before outputting the information included in said electronic mail (*Smith, col. 9, line 30 - col. 11, line 60*).

11. Claim 5 has similar limitations of claim 1; it is rejected under the same rationale as in claim 1.

12. As to claim 6, Smith-Thorne discloses, wherein said first server further comprises: an information managing section for managing performance information and installation position information for each of said printers (*Thorne, various status indications concerning printer, col. 4, lines 23-33; Fig. 1, address of printer in CDS 58*); and an information notifying section for notifying said client of at least one of the candidate printer or the plurality of candidate printers (*Smith, col. 2, line 8 – col. 3, line 16; col. 9, line 30 - col. 11, line 60*).

13. As to claim 7, Smith-Thorne discloses, wherein the electronic mail is utilized to perform communication between said client and said first server (*Smith, col. 2, line 8 – col. 3, line 16; col. 9, line 30 - col. 11, line 60*).

14. As to claim 8, Smith-Thorne discloses, further comprising an authentication apparatus for performing user authentication prior to print processing of said converted information in said designated printer (*Smith, col. 2, line 8 – col. 3, line 16; col. 9, line 30 - col. 11, line 60*).



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15. As to claim 9, Smith-Thorne discloses separating said electronic mail into a plurality of mail elements; and an individual managing section for individually managing said respective separated mail elements, and said information to be printed corresponds to one mail element (*Smith, col. 2, line 8 – col. 3, line 16; col. 9, line 30 – col. 11, line 60*).

16. As to claim 10, Smith-Thorne discloses a storing section in which the information constituting said electronic mail is stored; a monitor section for monitoring an empty capacity of said storing section; and a restricting section for restricting reception of a print request in accordance with lack of capacity of said storing section (*Smith, col. 2, line 8 – col. 3, line 16; col. 9, line 30 – col. 11, line 60*).

17. As to claim 11, Smith-Thorne discloses notifying said client of reception restriction when the reception of said print request is restricted (*Smith, col. 2, line 8 – col. 3, line 16; col. 9, line 30 – col. 11, line 60*).

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith-Thorne as applied to claims 1-11 above, and further in view of **Rudy** et al. U.S. patent # **6,369,252**.

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20. As to claim 12, Smith-Thorne does not explicitly disclose converting the information included in said electronic mail to a PDL file in accordance with said designated printer. Rudy disclose the PDF conversion as just available options (*Rudy, col. 21, lines 54-67*).

21. Claim 13 is similar limitation of claim 12; therefore, it is rejected under the same rationale as in claim 12.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith-Thorne as applied to claims 1-13 above, and further in view of the well-known feature of checking virus in the electronic mail.

24. As to claim 14, Cantwell-Thorne-Okada-Tanaka does not explicitly disclose executing a virus check with respect to said electronic mail.

The Examiner **takes Official Notice (see MPEP 2144.03)** that it is well known in the networking art to utilize virus-checking software for checking and execution of the method and system in order to provide the outputting. Therefore, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have included the virus checking program used in electronic mail because the virus

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checking programs is just the matter of design choices (see ***Chen et al.***, patent # **5,832,208**; col. 5, line 2 – col. 6, line 4).

25. Claims 15-16 are similar limitations of claim 14, 4; therefore, it is rejected under the same rationale as in claim 14, 4.

26. Claim 17 is similar limitations of claims 1,4; therefore, it is rejected under the same rationale as in claims 1, 4.

27. Claim 18 is similar limitations of claim 4; therefore, it is rejected under the same rationale as in claim 4.

28. Claim 19 is corresponding method claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

29. Claim 20 is corresponding computer readable medium of claim 1; therefore, it is rejected under the same rationale as in claim 1.

30. Claim 21 is similar limitations of claim 5; it is rejected under the same rationale as in claim 5.

31. As to claim 22, Smith-Thorne discloses, wherein the terminal is capable of sending and receiving electronic mail (*Smith, Fig. 1, workstation 150*).

***Claim Rejections - 35 USC § 103***

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claims 1-22 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over "PhaserLink Remote Internet Printing Software" User Manual by Tektronix as herewith **PhaserLink**.

34. PhaserLink taught the invention substantially as claimed (e.g., in exemplary claim 1) including an information output system comprising:

a managing section managing for managing a mail address for each output printing apparatus of an output printing apparatus group (*PhaserLink*, sections 2-5);

a search section for searching the output apparatus group managed by the managing section for one candidate output printing apparatus or a plurality of candidate output candidate output printing apparatuses in response to a search request having search conditions from a terminal apparatus (*PhaserLink*, sections 2-5);

notifying said terminal apparatus of the mail address of said candidate output printing apparatus or the plurality of candidate output printing apparatus found in a search by the search section, wherein the terminal apparatus issues an electronic mail to a destination mail address of a designate output printing apparatus, and wherein the destination mail address is based upon the mail address of said candidate output

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printing apparatus or the plurality of candidate output printing apparatus provided by the notifying section (*PhaserLink*, sections 2-5); and

distinguishing the designated output printing apparatus from said output printing apparatus from said output printing apparatus group based on the destination mail address of the electronic mail issued from said terminal apparatus, wherein said designated output printing apparatus produces printed output of outputting information included in the electronic mail issued from said terminal apparatus (*PhaserLink*, sections 2-5).

It would have been obvious to one of ordinary skill in the computer networking art at the time of the invention was made that the claimed invention differed from the teachings of *PhaserLink* only by the degree, e.g., in the claimed Remote Internet printing service. But this is no more a difference in a degree because the search request having search conditions or the printing service having a group of printers with the printer's email addresses configured and provided to users for searching and/or selection, they provide a selection for the user. The heart of the invention is providing a list or a table of the printers' email addresses to the user to search and to select an available printer based on search conditions. *PhaserLink* User Manual exactly were directed to the same purpose, i.e., to provide for a user an available printers based on their email addresses with greater system flexibility and reliability. Other claimed elements of the dependent claims are all obvious variation of the well-known features of Remote Internet Printing Services and rejected accordingly.

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35. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

### ***Response to Arguments***

36. Applicant's arguments and amendments filed on 17 October 2005 have been fully considered but they are not persuasive.

37. In the remarks, Applicant argued in substance that:

Point (A), the prior art do not discloses searching the output printing apparatus in response to the search request having search conditions from a terminal apparatus" in independent claims 1, 5, 17, 19, 20, and 21.

As to point (A), Smith discloses that, "*subscription request having publication criteria including a condition based on location or a condition based on information reported by another peripheral (Smith, col. 17, lines 43-56)*".

Thorne discloses that, "*wherein step d) causes a search to be made of communication data structures (CDS) 58 to determine which printers are available and match a client processor's print request requirements, (claim 3, col. 5, lines 29-31); the new instance CDS 58 includes, among other data, the name of the associated agent data structure, the address of new printer 12, data to enable communication with PSM 42, and further data which enables access to other procedures within program memory section 38, e.g., network interface/ communication procedure 46, MOD update procedure 48 and status update procedure 50, (Thorne, col. 4, lines 8-23)*".

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Point (B), Applicant traverses Official Notice taken by Examiner that the feature of "checking for a virus in an email" is deficient.

As to point (B), Applicant's traversal of Official Notice was clearly inadequate to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03(C). A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitation the Examiner considered as "well-known" in the first Office action through use of Official Notice, i.e. "checking for a virus in an email" in a networking environment, (*see Chen, US patent #: 5,832,208, col. 5, line 2 – col. 6, line 4*), are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). The provision for "checking for a virus in an email" does not constitute a patentable distinction.

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### ***Conclusion***

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen  
Examiner  
Art Unit 2142



THONG VU  
Primary Examiner  
